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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,597	06/08/2001	Barry H. Schwab	VID-01702/29	1591

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EXAMINER	
NASH, LASHANYA RENEE	

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/877,597	SCHWAB ET AL.	
	Examiner	Art Unit	
	LaShanya R Nash	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *September 10, 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to an Amendment filed September 10, 2004. Claims 1-11 are presented for further consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 -11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenz (US Patent 6,029,196) and further in view of Parulski et al. (US Patent 5241659).

In reference to claim 1, Lenz discloses a system to automatically configure client's preferences and settings through a server across a network. The invention eliminates the need for manually updating preferences on each individual computer system upon use. Lenz teaches:

- Transferring user preferences from one computer to another, "The users can store their own configurations and preferences on a central server instead of only on the local machine, thereby enabling the users to move freely between machines"(column 5 lines 13-15).

However, Lenz does not teach the application of a transportable data storage medium to save user preferences and subsequently transferring these user-defined configurations to other computer systems. Nonetheless this feature would have been an obvious modification to the aforementioned system disclosed by Lenz as evidenced by Parulski et al.

In an analogous art, Parulski et al shows a system to store user customized image parameter data on a storage device in order to augment the limited memory of a CD playing device. This system includes:

- A transportable data storage medium, "the use of an auxiliary removable memory to store customized image parameter data..."(column 1 lines 8-9).
- Recording on the transportable data storage medium, at a first computer, information relating to a user's computer configuration preferences, "This auxiliary, removable memory module permits the user to save customized image parameter data that the user has input to the microcontroller (as by way of a user interface, such as a hand-held remote control unit)"(column 3 lines 47-51).
- Receiving the transportable data storage medium at a second computer; and at least temporarily configure the second computer in accordance with the information stored in the transportable medium, "The cartridge can be then removed from the playback device and inserted into that or another playback device for controlling its operation"(column 3 lines 51-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply auxiliary removable memory devices to save user preferences for compact disc players as shown by Parulski et al to the implementation of automatic computer system configuration disclosed by Lenz.

The modification would have been obvious because one of ordinary skill in the art would have been motivated to apply a removable storage medium to load additional user configuration items not stored on the server to currently used computers. As a result, this application would increase the amount of available internal memory on the server and extend the functionality of the system to computers that are frequently connected and disconnected to the network.

In reference to claims 2 -4, Lenz teaches loading common configuration information (column 4 line 1) to various computers and discloses these customized preferences are inclusive of:

- Wired or wireless network or dial-up communications preferences, "E-mail addresses which is used as part of the configuration settings on the Client to set preferences for the Client's Internet browser"(column 3 lines 42-45).
- One or more user files or information relating to a user file, "the client's lock files"(column 1 line 59).

Lenz does not explicitly show transferring desktop graphical interface preferences between clients. However, Lenz does disclose, "one skilled in the art will readily appreciate that, although many facets of the Internet are mentioned as applications for

the invention, the same concepts of invention apply to other applications and fields as well" (column 3 lines 56-59).

In addition, Lenz does not show storing the previously specified user settings to a transportable medium. However, as applied to claim 1, Parulski et al shows utilizing a storage device to save customization information (column 3 lines 47-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to save preferences such as desktop graphical interface preferences, wireless network communication and user files to an auxiliary memory device. A person having ordinary skill in the art would have readily recognized that it would not be as advantageous to store configuration information that remains generally constant from user to user. Thusly, one of ordinary skill in the art would have been motivated to use this application in order for the automatic configuration to include such settings that are commonly unique to a specific user and subject to frequent modifications

In reference to claim 5, Lenz explicitly teaches a method of transmitting user preferences from the remote location of a server, to configure the current user's client. Lenz discloses:

- Accessing a remote location to a least temporarily configuring the second computer, "The client at start up, is optionally configured through a static server location file that points to the location of a of a server that is internal to the computer network site...The Server finds the configuration file and sends

the configuration file to the client"(column 2 lines 66-67 and column 3 lines 1-6).

In reference to claim 6, Lenz teaches that user settings and preferences used to configure the client system are stored on the server.

- Remote location includes data or an application program desired by the user at the second computer, "The file resides on the server and contains information for setting the client's lock files e.g. preferences, configuration information, and software versions"(column 1 lines 58-61).

In reference to claim 7, Lenz teaches that the software and settings are loaded from the client through booting the computer and through the log-on process.

- The step of at least temporarily configuring the second computer occurs through re-booting the second computer, "the client upon startup contacts the server for configuration information"(column 1 lines 65-66).
- Or through a different user log-on, "This allows the users to move to different machines and always be able to log in as themselves if they point to that same server"(column 5 lines 12-13).

In reference to claims 8 and 10, Parulski et al explicitly shows:

- Storage medium uses a magnetic, optical, magneto-optical, or semiconductor device, "stored on a transportable medium, such as a write-once optical compact disc"(column 4 lines 63-65).
- Storage medium is in the form of a disk or card, "transportable digital data storage medium, such as a 'smart card' or magnetic memory cartridge"(column 3 lines 43-46).

In reference to claim 9, neither Lenz nor Parulski et al shows prompting the user to remove a portable storage device. However, the examiner serves official notice that user prompts were well known and widely used in the art at the time of the invention.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to apply user prompts to remove the transportable medium to implement the method for customizing a client computer configuration as disclosed in Lenz. The modification would have been obvious because one of ordinary skill in the art would have been motivated to prompt the user to retain the storage medium in order to transfer the stored user unique identifier to other clients. Subsequently, configuring the currently used client computer system according to the user's preferences.

In reference to claim 11, Lenz discloses that the need for file updates are determined by the server and transmitted to a client to replace existing files (column 2 lines 12-14). Lenz applies client file updates in said invention to avoid manually updating files and settings for each computer individually. Lenz does not show saving

these updates to a storage device. Parulski et al, as applied to claim 1, discloses storing user preferences in an auxiliary memory device.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to store update information to a transportable medium. The modification would have been obvious because one of ordinary skill in the art would have recognized that it is advantageous to save file updates in order to download the appropriate users most current configuration at all clients upon transfer.

Response to Arguments

Applicant's arguments filed September 10, 2004 have been fully considered but have been determined non persuasive.

(I) Applicant contends that there is no motivation to combine Lenz to convert a system in which control of the configuration process is regulated to the user.

(II) Applicant contends there is no motivation to combine as Parulski shows that stored data contained in the removable memory module is related to the display of the specific images for the purpose of displaying those images in the manner desired by the user, and is not related to the configuration of a microprocessor or computer for purposes unrelated to the display of those images.

(III) Applicant contends with respect to Parulski, the examiner must determine what is "analogous art" for the purpose of analyzing the obviousness of the subject matter at issue.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant's arguments (I & II) are not commensurate with the claim language. The limitations of the claimed invention do not recite a requirement for control of the configuration process to lie with the client. In particular, the independent claim recites, inter alia, "recording on the transportable data storage medium, at a first computer, information relating to a user's computer configuration preferences". These limitations do not specify the aspects of computer configuration in which the preferences are related. Parulski is applied to teach the obviousness regarding a general method for storing user configuration preferences (i.e. image parameters) on a transportable data medium, regardless of the configuration characteristics of the preferences. Therefore, the applicant's arguments fail to present evidence that supports the lack of motivation to combine the aforementioned references, Lenz and Parulski. In addition, the examiner disagrees with applicant's argument (I). Lenz explicitly shows an automatic configuration method in which control of the configuration process is regulated to the user. Specifically, Lenz shows the user (i.e. client) controls initiation of the configuration sequence (Lenz column 1, line 64 to column 2, line 5). Lenz further shows that the user

directly controls configuration by determining information contained in the configuration file (i.e. JSC file). This file is subsequently employed to execute the configuration process (Lenz column 5, lines 9-16). Thus, Lenz suggests motivation for converting the automatic method for additional support of user-regulated configuration. As a result, applicant's argument (I) does not present substantial evidence to show that Lenz teaches away from Parulski and thereby shows no motivation for the aforementioned combination.

In response to applicant's argument (III) that Parulski is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Parulski is related to problem in which the applicant's claimed invention seeks to address. Parulski explicitly discloses storing user preferences on a computer readable medium for transporting configuration information to other computing devices (i.e. compact disc players), (Parulski column 2, lines 36-66), which is pertinent to the applicant's proposed problem. Therefore, Parulski is determined to be "analogous art" for the purpose of analyzing the obviousness of the subject matter at issue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya Nash whose telephone number is (703) 305-8910. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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